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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Roar Viala

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JAG Patent Services

1901 Old Middlefield Way

Suite 21

Mountain View, CA 94043-2556

EXAMINER

MONIKANG, GEORGE C

ART UNIT

PAPER NUMBER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/803,390	Applicant(s) VIALA, ROAR	
	Examiner GEORGE C. MONIKANG	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-18 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/2/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/2/2008 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-4, 10 & 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverman, US Patent 4,683,587.

Re Claim 1, Silverman discloses a system for underwater entertainment (fig. 1; col. 2, lines 22-35), the system comprising: a) media player unit for playing media data and generating audio signals therefrom (fig. 1; col. 2, lines 22-35); b) an input means for inputting the media data into the media player unit (fig. 1; col. 2, lines 22-35: FM receiver); c) a water resistant housing for housing the media player unit (fig. 1; col. 2, lines 22-35); and d) an output means for outputting the audio signals (fig. 1; col. 2, lines

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22-35), the output means comprising a water resistant ear plug/speaker unit with a sealed diaphragm (fig. 1; col. 2, lines 22-35) and a cone for inserting into a user's ear canal (fig. 1: 27 & 28; col. 2, lines 22-35), the ear/plug speaker unit being configured to deliver output audio signals to a user's ear while simultaneously plugging the user's ear (fig. 1; col. 2, lines 22-35).

Re Claim 3, Silverman discloses the system of claim 1, wherein the output means comprises a water resistant speaker for conducting the audio signals to a portion of a user's head (fig. 1; col. 2, lines 22-35).

Re Claim 4, Silverman discloses the system of claim 3, wherein the water resistant speaker comprises a connector feature for detachably coupling to an output port on the water resistant housing (fig. 1: 16, 27 & 28; col. 2, lines 22-35).

Re Claim 10, Silverman discloses the system of claim 1, wherein the input means comprises an input port for transmitting the media data to the media player unit from a media data source (fig. 1; col. 2, lines 22-35: FM receiver).

Re Claim 12, Silverman discloses the system of claim 1, wherein the water resistant housing comprises controls for operating the media player unit (fig. 1; col. 2, lines 22-35).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 2, 6 & 13-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman, US Patent 4,683,587 as applied to claim 1 above, in view of Jannard et al, US Patent Pub. 2004/0160572 A1. (The Jannard et al reference is cited in IDS filed 2/2/2007)

Re Claim 2, Silverman discloses the system of claim 1, but fails to disclose means for coupling the media player unit to a user's head as taught in Jannard et al (*Jannard et al, fig. 3a*). It would have been obvious to modify the submersible audio system of Silverman with the ability of coupling the media player unit to a user's head as taught in Jannard et al (*Jannard et al, fig. 3a*) for the purpose of creating a portable audio system.

4. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman, US Patent 4,683,587 as applied to claim 1 above, in view of Retchin et al, US Patent Pub. 2004/0062411 A1. (The Retchin et al reference is cited in IDS filed 2/2/2007)

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Re Claim 7, Silverman discloses the system of claim 1, but fails to disclose wherein the media player is an MP3 player configured to play MPEG-1 Audio Layer-3 compressed format media files as taught in Retchin et al (*Retchin et al, para 0047: mp3 player stores music*). It would have been obvious to use the MP3 player of Retchin et al (*Retchin et al, para 0047*) in place of the audio system of Silverman to provide a better audio system with better sound quality.

Claim 8 has been analyzed and rejected according to claim 7.

5. Claims 9 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman, US Patent 4,683,587.

Re Claim 9, which further recites, "Wherein the memory device comprises a removable memory unit." Silverman does not explicitly disclose a removable memory unit as claimed. Official notice is taken that both the concepts and advantages of providing a removable memory unit are well known in the art. It would have been obvious to use a removable memory unit since it is commonly used to transfer data at faster speeds (e.g. memory sticks).

Re Claim 11, which further recites, "Wherein the input port comprises a USB connection for coupling to the media data source through a computer." Silverman does not explicitly disclose a USB connection as claimed. Official notice is taken that both the concepts and advantages of providing a USB connection are well known in the art. It would have been obvious to use a USB connection since it is commonly used as a standard connection means with computers.

6. Claims 13 & 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Retchin et al, US Patent Pub. 2004/0062411 A1, in view of Silverman, US Patent 4,683,587. (The Retchin et al reference is cited in IDS filed 2/2/2007)

Re Claim 13, Silverman discloses a system for playing digital media data, the system comprising an underwater media player comprising: a) a media storage unit for storing the digital media data (para 0047: mp3 player); b) a digital processor for reading and converting the digital media data into audio output signals (para 0047: mp3 player); and c) means for transmitting the audio output signals to a water resistant audio output unit (para 0047), wherein a user can listen to the audio output signals from water resistant earphones while submersed in water (abstract) but fails to disclose the water resistant earphones placed in a user's ear canal (Silverman, fig. 1: 27 & 28; col. 2, lines 22-35), wherein the water resistant earphones include a cone for inserting into the user's ear canal as taught in Silverman (Silverman, fig. 1: 27 & 28; col. 2, lines 22-35). It would have been obvious to modify the system of Retchin et al with speakers that can be plugged into the ear canal of a user as taught in Silverman (Silverman, fig. 1: 27 & 28; col. 2, lines 22-35) for the purpose of protecting the user's ears from water.

Re Claim 15, the combined teachings of Retchin et al and Silverman disclose the system of claim 13, further comprising means for transmitting the digital media data to the media storage unit from a media data source (Retchin et al, para 0021).

Re Claim 16, the combined teachings of Retchins et al and Silverman disclose the system of claim 15, wherein the means for transmitting the digital media data to the

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media storage unit from the media data source comprises one or more of a physical connection and a wireless receiver (Retchin et al, para 0021).

Re Claim 17, the combined teachings of Retchin et al and Silverman disclose the system of claim 13, wherein the digital processor is configured to decompress the media data stored on the media storage unit in a compressed format (Retchin et al, para 0047).

Claim 18 has been analyzed and rejected according to claim 17.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Retchin et al, US Patent Pub. 2004/0062411 A1 and Silverman, US Patent 4,683,587, as applied to claim 13 above, in view of Jannard et al, US Patent Pub. 2004/0160572 A1. (The Retchin et al and Jannard et al references are cited in IDS filed 2/2/2007)

Re Claim 14, the combined teachings of Retchin et al and Silverman disclose the system of claim 13, further comprising a water resistant housing for housing the media storage unit and the digital processor (Retchins et al, para 0046-0047), but fails to disclose the water resistant housing being configured for coupling to the user's head as taught in Jannard et al (Jannard et al, fig. 3a). It would have been obvious to modify the submersible audio system of Retchin et al and Silverman with the ability of coupling the media player unit to a user's head as taught in Jannard et al (Jannard et al, fig. 3a) for the purpose of creating a portable audio system.

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8. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Retchin et al, US Patent Pub. 2004/0062411 A1, in view of Silverman, US Patent 4,683,587, and further in view of Jannard et al, US Patent Pub. 2004/0160572 A1. (The Retchin et al and Jannard et al references are cited in IDS filed 2/2/2007)

Re Claim 21, Retchin et al discloses a system for playing music while in a water environment, the system comprising: a) an MP3 player and recorder contained within a water resistant housing for playing and recording MP3 files (para 0047); but fails to disclose b) one or more water resistant ear phones with sealed membrane transducers coupled to a player and recorder for producing audible representations of the player with the one or more water resistant sealed membrane that is used in a cone shaped member for inserting into a user's ear canal as taught in Silverman (Silverman, fig. 1: 27 & 28; col. 2, lines 22-35). It would have been obvious to modify the system of Retchin et al with speakers that can be plugged into the ear canal of a user as taught in Silverman (Silverman, fig. 1: 27 & 28; col. 2, lines 22-35) for the purpose of protecting the user's ears from water. The combined teachings of Retchin et al and Silverman also fail to disclose c) an input port for down-loading MP3 files from a computer as taught in Jannard et al (Jannard et al, para 0075). It would have been obvious to modify the audio system of Retchin et al and Silverman with the input port for down-loading MP3 files from a computer as taught in Jannard et al (Jannard et al, para 0075) to enable the audio system to be able to receive digital signals from other devices.

Re Claim 22, the combined teachings of Retchin et al, Silverman and Jannard et al disclose the system of claim 21, further comprising means for coupling the MP3 player and recorder to a portion of the user's body (*Jannard et al, abstract; fig. 3a*).

Re Claim 23, the combined teachings of Retchin et al, Silverman and Jannard et al disclose the system of claim 22, wherein the means for coupling the MP3 player to the portion of the user's body comprises a strap (*Jannard et al, para 0081; fig. 3a: 54' & 56'*).

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GEORGE C. MONIKANG whose telephone number is (571)270-1190. The examiner can normally be reached on M-F. alt Fri. Off 7:30am-5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chin Vivian can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George C Monikang/
Examiner, Art Unit 2614

11/07/2008

/Vivian Chin/
Supervisory Patent Examiner, Art Unit 2614